TRANSCRIPT OF RECORD
IN FOUR VOLUMES

FILED
AUG 30 1951
CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

October Term, 1951

No. 290

PHOTOCHART, a Corporation, and LORENZO DEL RICCIO,

Petitioners,

vs.

PHOTO PATROL, INC., a Corporation; PACIFIC TURF CLUB, INC., a Corporation; AMERICAN TELETIMER CORPORATION and ROBERT OSWALD,

Respondents.

Volume IV
(Pages 519 to 532)

PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

342 U.S.

Phillips & Van Orden Co., 870 Brannan Street, San Francisco, Calif.

No. 12640

United States
Court of Appeals
For the Ninth Circuit

PHOTOCHART, a Corporation, and LORENZO DEL RICCIO,

Appellants,

vs.

PHOTO PATROL, INC., a Corporation; PACIFIC TURF CLUB, INC., a Corporation; AMERICAN TELETIMER CORPORATION and ROBERT A. OSWALD,

Appellees,

and

PHOTO PATROL, INC., a Corporation; AMERICAN TELETIMER CORPORATION and ROBERT A. OSWALD,

Appellants,

vs.

PHOTOCHART, a Corporation, and LORENZO DEL RICCIO,

Appellees.

Volume IV
(Pages 519 to 532)

Appeals from the United States District Court, Northern District of California, Southern Division.

Proceedings Had in the United States Court of Appeals for the Ninth Circuit

Phillips & Van Orden Co., 870 Brannan Street, San Francisco, Calif.

United States Court of Appeals
for the Ninth Circuit

Excerpt from Proceedings of Thursday, May 3, 1951.

Before: Stephens, Bone and Pope,
Circuit Judges.

[Title of Cause.]

ORDER OF SUBMISSION

Ordered appeal herein argued by Mr. Collins Mason, counsel for appellants, and by Mr. Julian Caplan, counsel for appellees, and submitted to the court for consideration and decision.

United States Court of Appeals
for the Ninth Circuit

Excerpt from Proceedings of Monday, June 11, 1951.

Before: Stephens, Bone and Pope,
Circuit Judges.

[Title of Cause.]

ORDER DIRECTING FILING OF OPINION AND FILING AND RECORDING OF JUDGMENT

Ordered that the typewritten opinion this day rendered by this court in above cause be forthwith filed by the clerk, and that a judgment be filed and recorded in the minutes of this court in accordance with the opinion rendered.

United States Court of Appeals
for the Ninth Circuit
No. 12,640

PHOTOCHART, a Corporation, and LORENZO DEL RICCIO,

Appellants,

vs.

PHOTO PATROL, INC., a Corporation; PACIFIC TURF CLUB, INC., a Corporation; AMERICAN TELETIMER CORPORATION and ROBERT A. OSWALD,

Appellees,

and

PHOTO PATROL, INC., a Corporation; AMERICAN TELETIMER CORPORATION and ROBERT A. OSWALD,

Appellants,

vs.

PHOTOCHART, a Corporation, and LORENZO DEL RICCIO,

Appellees.

June 11, 1951

Appeals from the United States District Court, Northern District of California, Southern Division

Before: Stephens, Bone and Pope,
Circuit Judges.

Bone, Circuit Judge.

OPINION

Plaintiffs (appellants) Lorenzo del Riccio and Photochart Corporation, brought this action charging patent infringement and unfair competition.

The patent in suit (Reissue Patent No. 22,881) is a method of photographically recording the finish of horse races. The idea embodied in the patent was conceived by del Riccio and was referred to throughout the trial as the del Riccio method. A full understanding of the issues on this appeal necessitates a brief outline of the facts.

Del Riccio first employed the method in suit in July, 1937. At that time del Riccio had in his employ one Harry Belock, a photography engineer, whose duties were designing, constructing and operating photo-finish cameras. Belock terminated his employment with del Riccio in January or February of 1938 and in October of that year applied for a patent on a method of photographing the finish of horse races by the use of "slit photography." Patent No. 2,257,100 was issued to Belock as a result of this application, which patent he assigned to American Teletimer Corporation, one of the defendants in this action.[1]

Del Riccio did not apply for a patent on his method until March 20, 1939—a period of approximately six months after the Belock application. Del Riccio received a patent on June 1, 1943. The patent in suit is a reissue of that original patent. Photochart Corporation is the licensee of del Riccio, and is engaged in the business of photographing the finish of horse races.

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[1]No appeal was taken from that part of the judgment which holds that American Teletimer has not infringed appellants' patent. It may also be noted that Belock was not made a party to this litigation.

In 1941 Robert Oswald, a defendant-appellee, was employed by Photochart as a photo-finish camera operator. He later became a licensee of Photochart and operated on his own at various racing events, particularly county fairs, using a camera he had constructed and with which he practiced the del Riccio method. About 1947 Oswald began to operate under a license from American Teletimer, operating at county fairs and still using the camera he had constructed. Sometime around this period he became associated with defendant-appellee, Photo Patrol, a competitor of Photochart. At the time this litigation was commenced Oswald was operating a camera for Photo Patrol at a race track known as Golden Gate Fields,[2] under a licensing agreement with American Teletimer Corporation. Oswald was using the camera he had constructed and also one furnished by American Teletimer.

The patent in suit is designated as a method of photographically recording the order of passage of moving objects. It involves the use of a device, old in the art, known as the "slit camera."[3] This camera, in place of a shutter, has a narrow slit in the film masking plate, which plate is located between the film and the camera lens. When the camera is in operation the film is continuously moving and continuously exposed through the nar-

[2]The operators of this track, The Pacific Turf Club, were named as defendants in this action, but were dismissed from the suit by stipulation of the parties.

[3]The slit camera was patented in 1901, Pasquarelli Patent No. 683,573.

row slit. The principal use of the slit camera is to take panoramic scenes by moving the camera in a sweeping motion simultaneously with the movement of the film. If the camera is held in a fixed position only those objects in motion will be recorded on the film. This feature of the slit camera is utilized by the del Riccio method.

In practicing the del Riccio method the camera is placed in an elevated position on the outside of the race track. As the horses approach the finish line the film in the camera is moving in the direction of the image of the horses (which is opposite to the direction the horses are moving). The speed of the film is adjusted to the speed of the image of the horses. In a counter-clockwise race the finish line of the track and the optical axis of the camera lens[4] are aligned with the right hand edge of the narrow slit. The effect of this alignment is that the film does not commence to record a picture of a horse until the horse's nose reaches the finish line. In other words the entire area of the track up to the finish line is eliminated from the zone of photography. By this system the horse whose nose first commences to be recorded on the film is determined to be the winner.

It is the claim of appellants that the normal use of the slit camera would be to align the center of the slit with the optical axis of the lens and the finish line; that because the zone of photography

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[4]The optical axis of the lens refers to an imaginary line that goes through the heart of the lens where there is no refraction or bending of light.

enlarges in a cone shape away from the lens of the camera the field of vision is a fan-shaped area of the track which is bisected by the finish line. Under these conditions, it is said, it is impossible to get an accurate picture of the winning horse because of the problem of angular vision. For example, a horse on the far side of the track (in reference to the location of the camera) would come into the field vision and might appear to be the winning horse even though a horse on the side of the track adjacent to the camera actually crossed the finish line first. The del Riccio method, which masks out the entire area of the track up to the finish line by the alignment mentioned, has eliminated this problem of angular vision and is claimed to have achieved a degree of accuracy never obtained before.

Appellees admit that they align one edge of the slit with the finish line of the track, but contended that their method disregards the optical axis of the lens. Oswald testified that an accurate photograph of the finish can be taken without bringing the optical axis into the alignment.

Appellants in their complaint and supplemental complaint charged infringement of the claims of six patents owned or controlled by them and further charged infringement of the Belock patent. Several of the patents were dropped from the suit prior to the trial and others were withdrawn sometime prior to judgment. The amended judgment of the district court recites that all claims except claims 1, 2, 7 and 8 of Reissue Patent No. 22,881 were withdrawn prior to judgment. The charge of unfair competi-

tion was based on the claim that Belock and Oswald had acquired trade secrets of the appellants while employed by the latter in a confidential relationship and had appropriated these trade secrets to their own use without the consent of appellants. This charge of unfair competition is not urged as a separate issue on this appeal but only to show aggravated infringement.

The district court made findings of fact and conclusions of law and entered judgment for the defendants. The substance of the court's findings is that Reissue Patent No. 22,881 is invalid for want of invention and that the subject matter thereof was old in the art more than one year before the del Riccio patent application was filed. It further found that it was within the reasonable and expected skill of anyone working in the art.

On the issue of infringement the court found that appellees had not aligned the optical axis with the edge of the slit and the finish line and therefore had not infringed. The court found that no trade secrets were involved and that the defendants had not engaged in unfair competition. By an order the court denied the defendants' request for attorneys' fees and the defendants appeal from that order.

In the posture the case reaches us we are concerned only with claims 1, 2, 7 and 8 of Reissue Patent No. 22,881, and with the appeal by the defendants from the order of the district court denying attorneys' fees.

It is not contended that the patent in suit contains any new or different element not existing in

the prior art. If its validity is to be upheld it must be on the theory that the del Riccio method is a combination of old elements which constitute invention. There is no exact standard by which a court may determine when a combination of old elements constitutes invention and when it is within the mechanical skill of one working in the art. The most recent opinion of the Supreme Court on combination patents expresses the view that, "courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements." Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147. The test to be applied to such patents is that the combination must perform some new or different function—one that has unusual or surprising consequences.[5] It is our view that the patent in suit fails to meet this severe test and does not constitute invention. The most that can be said for the patent in suit is that it rearranges the elements of the slit camera in such a manner that in the performance of their respective functions a higher degree of accuracy is obtained. But perfection of workmanship, however useful or convenient, does not constitute invention. Cuno Corp. v. Automatic Devices Corp., 314 U.S. 84; Dow Chemical Co. v. Halliburton Oil Well Cementing Co., 324 U.S. 320; Hollywood-Maxwell

[5]Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147; Cuno Engineering Corp. v. Automatic Devices Corp., 314 U.S. 84; Toledo Co. v. Standard Parts, 307 U.S. 350.

Co. v. Street's of Tulsa, 10-Cir., 183 F. 2d 261; Shaffer v. Armer, 10-Cir., 184 F. 2d 303. Each element of the slit camera utilized in the del Riccio method is performing the same function it has always been known to perform. Del Riccio has changed the position of one of these elements (the narrow slit) which results in a restricted field of vision coincident on one side with the finish line. This result, however useful, has added nothing to the total stock of knowledge. In our view this variation of an old device is within the reasonable skill of one working in the art.

Appellants contend that in all the years the slit camera has been in existence many improvements have been made on it, but no one discovered the method in suit except del Riccio. This, it is said, indicates that more than skill was involved. However, there is no showing in the evidence that there was any long felt want for this improvement nor any widespread effort to solve the problem of angular vision which the del Riccio method eliminated.[6] Toledo Co. v. Standard Parts, supra. Commercial success is relevant only in a doubtful case and will sometimes tip the scales in favor of invention. Jungersen v. Ostby & Barton Co., et al., 335 U.S. 560.

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[6]The essence of the del Riccio method is alignment of one edge of the slit and the optical axis of the lens with the finish line to mask out the entire area of the track up to the finish line. The Australian Patent to Cowdry, No. 104,941 (1938), discloses a shield located in front of the lens of a motion picture camera the purpose of which is to cut off from the camera's "vision" the entire area of the track up to the finish line.

In a case, such as this, where invention is plainly lacking, commercial success is immaterial.

Having determined that the patent lacks invention it is unnecessary for us to determine the questions of infringement and unfair competition.[7]

We come now to the appeal by the defendants from the order denying attorneys' fees. The basis of this claim is that the plaintiffs unduly complicated the issues by reckless charges of patent infringement, by failure to take any steps prior to trial to reduce the number of issues, and by evading any effort of the defendants to reduce the issues. Because of these circumstances, it is claimed that the defendants were obliged to expend more time and expense in preparing a defense than was necessary and that the trial court erred in denying attorneys' fees. 35 U.S.C.A., Section 70, provides in part:

> "* * * The court may in its discretion award reasonable attorneys' fees to the prevailing party upon the entry of judgment on any patent case."

While there is some evidence to support the defendants' contentions the facts of the case are not so clear cut that we are able to say that the trial judge abused his discretion in denying an award of attorneys' fees. Many of the cases relied on by defendants are cases affirming an award made by the district court. Dubil, et al., v. Rayford Camp

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[7]As noted before the latter question is not asserted here as a separate issue but only to show aggravated infringement.

& Co., et al., 9-Cir., 184 F 2d 899, relied on by defendants, recognizes the rule that an appellate court should not interfere with the discretionary power of the trial court except where there is an abuse of discretion amounting to caprice or an erroneous conception of law on the part of the trial court. Defendants have misread the decision of this court in Buck v. Bilke, 63 F. 2d 477. The decision did not change the judgment with respect to attorneys' fees but modified it only by adding damages which were "mandatory" under the statute.

The judgment of the district court is affirmed.

[Endorsed]: Opinion. Filed June 11, 1951. Paul P. O'Brien, Clerk.

United States Court of Appeals
for the Ninth Circuit

No. 12,640

PHOTOCHART, a Corporation, and LORENZO DEL RICCIO,

vs.

PHOTO PATROL, INC.; PACIFIC TURF CLUB, INC.; AMERICAN TELETIMER CORP., and ROBERT A. OSWALD.

PHOTO PATROL, INC.; AMERICAN TELETIMER CORP., and ROBERT A. OSWALD,

vs.

PHOTOCHART and LORENZO DEL RICCIO.

JUDGMENT

Appeals from the United States District Court for the Northern District of California, Southern Division.

This Cause came on to be heard on the Transcript of the Record from the United States District Court for the Northern District of California, Southern Division, and was duly submitted.

On Consideration Whereof, It is now here ordered and adjudged by this Court, that the judgment of the said District Court in this Cause be, and hereby is affirmed.

Filed and entered June 11, 1951.

United States Court of Appeals
for the Ninth Circuit

Excerpt from Proceedings of Friday, July 20, 1951.

Before: Stephens, Bone and Pope,
Circuit Judges.

[Title of Cause.]

ORDER DENYING PETITION FOR REHEARING

Upon consideration of the petition of appellants Photochart and Lorenzo Del Riccio, filed July 9, 1951, and within time allowed therefor by rule of court, for a rehearing of above cause, and by direction of the court,

It Is Ordered that said petition be, and hereby is denied.

United States Court of Appeals
for the Ninth Circuit

CERTIFICATE OF CLERK, U. S. COURT OF APPEALS FOR THE NINTH CIRCUIT, TO RECORD CERTIFIED UNDER RULE 38 OF THE REVISED RULES OF THE SUPREME COURT OF THE UNITED STATES

I, Paul P. O'Brien, as Clerk of the United States Court of Appeals for the Ninth Circuit, do hereby certify the foregoing Transcript of Record in four volumes, containing 531 pages, numbered from and including 1 to and including 531, to be a full, true and correct copy of the entire record, excluding certain original exhibits, of the above-entitled case in the said Court of Appeals, made pursuant to request of counsel for the appellants, Photochart and Del Riccio, and certified under Rule 38 of the Revised Rules of the Supreme Court of the United States, as the originals thereof remain on file and appear of record in my office.

Attest my hand and the seal of the said the United States Court of Appeals for the Ninth Circuit, at the City of San Francisco, in the State of California, this 17th day of August, 1951.

[Seal] PAUL P. O'BRIEN,
Clerk.

FILED
AUG 30 1951
CLERK

IN THE

Supreme Court of the United States

October Term, 1951.

No. 290

PHOTOCHART, a Corporation, and LORENZO DEL RICCIO,
Petitioners,

vs.

PHOTO PATROL, INC., a Corporation, PACIFIC TURF CLUB, INC., a Corporation, AMERICAN TELETIMER CORPORATION, and ROBERT A. OSWALD,
Respondents.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit, and Supporting Brief.

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IN THE

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October Term, 1951.

No. .....

PHOTOCHART, a Corporation, and LORENZO DEL RICCIO,
Petitioners,

vs.

PHOTO PATROL, INC., a Corporation, PACIFIC TURF CLUB, INC., a Corporation, AMERICAN TELETIMER CORPORATION, and ROBERT A. OSWALD,

Respondents.

Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

To the Honorable, the Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Your petitioners, Photochart, a corporation, and Lorenzo del Riccio, plaintiffs-appellants below, respectfully pray that a writ of certiorari issue to the United States Court of Appeals for the Ninth Circuit to review a judgment of that Court [R. 530], entered June 11, 1951, opinion appearing at R. 520, affirming a judgment of the United States District Court for the Northern District of California, Southern Division [R. 87], in favor of the respondents, who were defendants-appellees below. The action was dismissed as to Pacific Turf Club, Inc., a corporation, before trial.

Statement.

The proceeding in the District Court was petitioners' complaint [R. 2], for infringement of claims 1, 2, 7 and 8 of United States Reissue Letters Patent No. 22,881 [R. 393], for a new method of photographically recording the order in which a number of objects, *moving side by side,* pass a fixed point, such as horses crossing the finish line of a race track or athletes crossing the finish line in a track meet. The patent issued to petitioner del Riccio and the method will be referred to as the "del Riccio method."

The judgment of the District Court held the patent claims invalid for lack of invention, and the judgment was affirmed by the United States Court of Appeals for the Ninth Circuit.

The combination of physical elements used by del Riccio in carrying out his method, is old, being those elements comprising the "slit" camera, invented in 1901.*

What del Riccio invented was *a new mode of operating that old combination of elements,* which so changed its operative effect as to produce a new and entirely unexpected result overcoming the old problem of "angular viewing." That problem had, for 37 years, prevented the "slit" camera from being used to photograph a *plurality* of objects *moving side by side* past a fixed point.

In passing upon the patent in suit, the Court below treated the del Riccio method merely as a "combination of old elements," and used, as its controlling precedent, this Court's recent opinion in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.,* 340 U. S. 147, involving entirely nonanalogous facts, instead of relying

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*Pasquarelli patent 683,673 [R. 545].

upon those truly analogous decisions of this Court involving patents for new modes of operating old combinations of elements which so changed their operative effect as to produce new and unexpected results, as typified by this Court's decision in *Keystone Mfg. Co. v. Adams,* 151 U. S. 142. Petitioners respectfully urge that this was error.

Jurisdiction.

Jurisdiction of this Court is based upon Section 1254 of Title 28, U. S. C. A.

Questions Presented.

1. Is not the decision of the Court below contrary to the decisions of this Court in cases involving like facts and principles?

2. Did this Court intend the language of its opinion in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.,* 340 U. S. 147, to announce a new test of invention overruling former decisions of this Court sustaining patents for new modes of operating old combinations producing new and unexpected results?

Reasons for Allowance of Writ.

Apart from what petitioners contend to be the injustice resulting from the judgment below, a serious question of public importance is presented.

When construed in the light of the facts of the case, this Court's opinion in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., supra,* is believed merely to constitute a more forceful statement of the settled rule that a combination of old elements, to be patentable, must produce a combined result amounting to something more than normally would be expected by one aware of the

customary functions of the elements. However, the Court below has misconstrued it, and other Courts are apt to misconstrue it, as announcing a new and more severe test of invention—a test which would render unpatentable any *improvement* invention as distinguished from an invention of an entirely new art.

All machines, no matter how meritorious, are combinations of old elements, and unless the lower Courts correctly interpret and apply this Court's opinion in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., supra,* there is real danger that the result will be such a continuous discouragement of inventive effort as to threaten our industrial supremacy. This would be particularly disastrous since our chief enemy country is striving to overcome our technological superiority by paying substantial cash awards to its inventors in an effort to stimulate inventive effort.

Improvement inventions are as essential to our industrial advancement as are inventions of new arts, and any misinterpretation of this Court's opinion which would have the unfortunate effect of discouraging the improvement of our machines and arts should be corrected. By correcting the error of the judgment below, this Court will clarify the intent of its opinion in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*

Wherefore, your petitioners pray that the writ sought by this petition be granted.

Respectfully submitted,

COLLINS MASON,
Attorney for Petitioner Photochart, a Corporation.

DON MARLIN,
WILLIAM H. LEVIT,
Attorneys for Petitioner Lorenzo del Riccio.

IN THE

Supreme Court of the United States

October Term, 1951.

No. .....

PHOTOCHART, a Corporation, and LORENZO DEL RICCIO,
Petitioners,

vs.

PHOTO PATROL, INC., a Corporation, PACIFIC TURF CLUB, INC., a Corporation, AMERICAN TELETIMER CORPORATION, and ROBERT A. OSWALD,

Respondents.

Brief in Support of Petition for Writ of Certiorari.

I.
The Opinion Below.

The United States Court of Appeals for the Ninth Circuit entered Judgment on June 11, 1951 [R. 530]. Petition for rehearing was denied July 20, 1951 [R. 531]. The opinion appears at R. 520.

II.
Jurisdiction.

Jurisdiction is conferred by Section 1254 of Title 28, U. S. C. A.

III.
Statement of Case.

The petition sets forth a statement beginning at page 2.

IV.

Specification of Errors.

1. The decision of the Court below is contrary to the decisions of this Court in cases involving like facts and principles.

2. In reaching its decision, the Court below has erroneously attributed to the opinion of this Court in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, a meaning not believed to have been intended by this Court, and, therefore, a question of public importance is raised.

V.

ARGUMENT.

1. The Patent in Suit.

The patent in suit is for a new *method* of photographically recording the order in which a number of objects, moving side by side or in parallel lines, pass a fixed point, such as contestants in a race passing a finish line. The principal uses for the method are in photographing race finishes, such as horse races and track events. A typical claim of the patent reads as follows:

> "2. The method of making a photographic record of contestants crossing a finish line of a race upon a course, which comprises the steps of positioning a photographic camera to one side of and above said course with the optical axis of its objective in alignment with said finish line, continuously projecting through said objective the images of said contestants upon a light sensitive surface in said camera and at the same time moving said sensitive surface in the same direction and at substantially the same speed

as said images and maintaining a masking element in front of said sensitve surface having an exposure aperture in the form of a narrow slit extending transversely of the direction of movement of said sensitive surface, and aligning one side edge of said exposure aperture with the optical axis of said objective and with said finish line so that the area of exposure of said sensitive surface is continuously confined to a narrow strip extending transversely of the direction of movement of said sensitive surface which is in optical correspondence with the said finish line and an area of said course adjoining said finish line on only one side thereof."

The photographic equipment used in practicing the del Riccio method is old. The patented method teaches a new mode of operating the old equipment, which changed its operative effect to produce a new and unexpected result,—*a result which, according to the teachings of the prior art,* should have been a failure.*

2. The Prior Art.

To better understand the del Riccio method, it is best first to discuss the methods and equipment used for the purpose prior to the del Riccio invention, which was made in 1937.

The method in universal use at the time del Riccio completed his invention, was to use a conventional motion picture camera, which photographed the finish wire and the contestants as they passed under the wire.

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*Johnson patent 776,403 [R. 466]; Pasquarelli patent 683,673 [R. 545]; Odell patent 1,266,616 [R. 458]; Debrie patent 146,878 [R. 452, 431]; Debrie patent 336,367 [R. 423]; Landwerlin patent 569,475.

However, that method allowed considerable margin of error [R. 134]. Motion picture cameras make a series of still pictures on intermittently moving film, the film being advanced between shots while a shutter closes the camera aperture. Consequently, it is quite possible that the shutter may be closed at the moment a given contestant crosses the finish line; and a racing horse, for instance, can travel about a foot and a half while the camera shutter is closed between shots. Moreover, the finish wire stretched across a race track is seldom straight. Being about 100 feet long, the wind blowing up or down the track causes the wire to bow either towards or away from the direction of travel of the horses, thus resulting in the end horses being at an advantage or disadvantage over the intermediate horses, depending upon the direction of the wind.

It is not surprising, therefore, that, prior to the del Riccio method, disputes often arose as to the accuracy of photographs of close race finishes [R. 123]. A small margin of error in a close race may result in the wrong contestant being declared the winner.

In solving the problem, del Riccio used an old type of camera, the "slit" camera, whose principal use had been in making panoramic pictures.

A "slit" camera is one in which a *continuously moving* film is *continuously exposed* through a narrow slit formed in a film masking plate located between the film and the camera lens, no shutter being used. It was invented in 1901.*

In using a slit camera, if a picture of a stationary object, such as a landscape, is being made, the camera itself

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*Pasquarelli patent 683,673 [R. 545].

must be moved in a sweep simultaneously with movement of the film. *If the camera is held stationary while the film is moved, the film will only record objects in motion.* Thus, while moving objects, such as contestants in a race, would be recorded on the film, the finish wire or marker, being stationary, would not be recorded. Consequently, the winning contestant would be photographically recorded as the one first coming within the track area to which the film is exposed through the slit. For instance, a picture of a horse race finish, *taken by the del Riccio method,* would appear as shown in the following sketch, in which it will be observed that there is no picture of the finish wire.

PLATE 1.

While slit cameras had been used to photograph a *single* moving object,* prior to the del Riccio method slit cameras could not be used to accurately photograph the order in which a number of objects, moving side by side, pass a fixed point.

This was because of the old problem of "angular viewing," now to be discussed.

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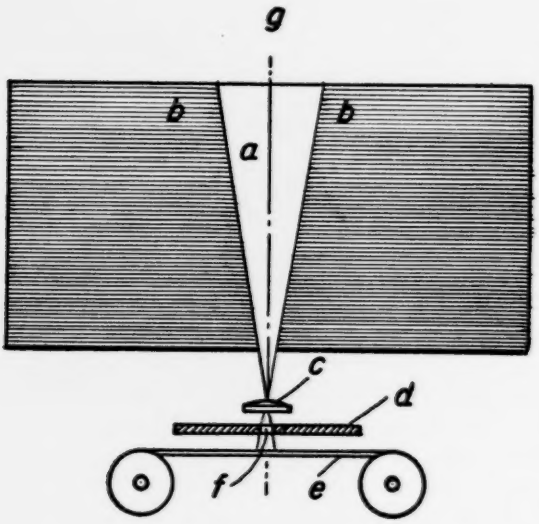
*Petrie patent 336,367 [R. 423]; Landwerlin patent 569,475 [R. 439].

Good photographic practice had always dictated that, in focusing a camera, everything must be centered and balanced. Thus, those using the slit camera prior to del Riccio taught that the lens axis and the *center* of the slit in the film masking plate *must be* in alignment with the object.

Such an arrangement, however, exposes the film to a conical or fan-shaped area of a race track bisected by the actual finish line, as shown in the next following sketch:

PLATE 2.

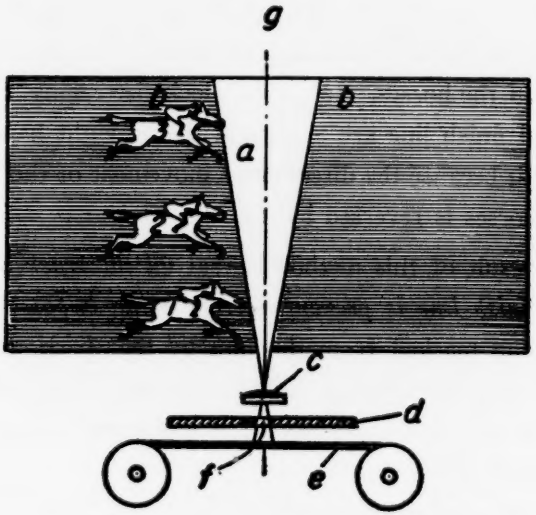


EXPLANATION: (a) is the fan-shaped track area bisected by finish line (g), to which the film (e) is exposed through slit (f) in masking plate (d). (c) is camera lens whose optical axis is aligned with the center of slit (f). (b) is the track area masked from film by plate (d). Finish wire (g) does not register on film because it is stationary.

It is easy to see that the horses adjacent the rail, or at the inside of the track, have an advantage over those at the outside of the track, because those adjacent the rail are the first to enter the fan-shaped track area to which the film is exposed through the slit.

For instance, horses crossing the finish line in the order shown in Plate 1, *if photographed in accordance with prior art teachings,* would be incorrectly recorded to show that the horse finishing third was the winner, while the real winner would be recorded as being third. This is illustrated by superimposing Plate 1 on Plate 2 as shown in the next following sketch:

PLATE 3.



EXPLANATION: Horse No. 3, which actually finished third, would be recorded on the film as being first, because it first entered the fan-shaped track area (a) to which the film (e) is exposed through slit (f). Horse No. 1, the actual winner, would be recorded as finishing third.

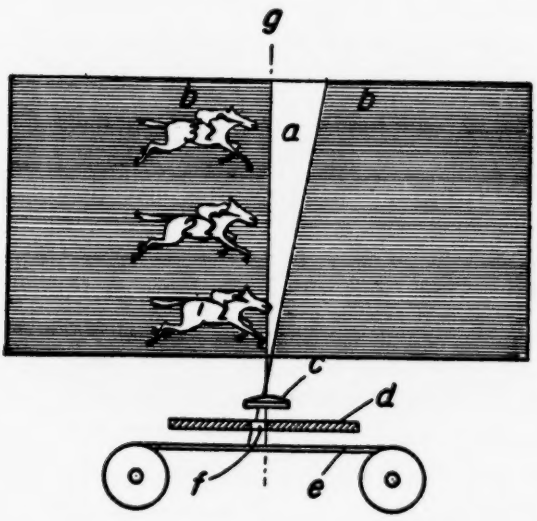
This illustrates the problem of "angular viewing," which, until del Riccio discovered his new method of operating the elements of a slit camera, had been considered to be an insurmountable obstacle to using slit cameras to photograph the order in which a plurality of objects, moving side by side, pass a fixed point.

3. The del Riccio Method.

Del Riccio discovered that he could overcome "angular viewing" by going contrary to the teachings of the prior art, and by so lining up the elements of the slit camera as to bring the optical axis of the lens and *one edge* (instead of the center) of the slit into alignment with the finish line, and then by moving the film continuously past the slit in the direction and at about the speed of the images of the horses. In counterclockwise racing, the lens axis and finish line are aligned with the right hand edge of the slit because the direction of movement of the images of the horses is reversed by the lens.

The result of this method is that *all the track area up to the finish line is prevented from being exposed to the film,* being masked from the film by that portion of the film masking plate to the right of the slit. Thus, the film does not commence to record the image of a horse until the horse's nose actually crosses the finish line, as shown in the next following sketch.

PLATE 4.



EXPLANATION: Due to the fact that the right hand edge of slit (f) is aligned with the axis of lens (c) and with the finish line (g), the left hand border of the track area (a) to which the film is exposed is directly along the finish line instead of at an angle thereto, thus causing the horses to record on the film in the true order in which they cross the finish line.

It is thus seen that, *by the del Riccio method, the mode in which the images are either masked from or transmitted to the film, is so changed that it is impossible to obtain an inaccurate picture of a race finish.*

The del Riccio method was promptly adopted by about 70 percent of the race tracks, supplanting all other methods [R. 280].

4. Error of the Court Below.

In stating the reasoning underlying its holding of the patent claims invalid for lack of invention, the Court below stated, in its opinion [R. 520], as follows:

> "If its validity is to be upheld it must be on the theory that the del Riccio method is a combination of old elements which constitute invention."

The Court below then proceeded to apply this Court's decision in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, and other decisions,* relating to combinations of old elements wherein each of the old elements continued to perform nothing more than its expected and normal function.

Petitioners respectfully submit, however, that neither the facts nor the reasoning of the cited decisions afford a fair and reasonable basis for an evaluation of the del Riccio method.

Del Riccio has never claimed to have invented a new combination of elements. He took the same combination of elements which had constituted the slit camera for 37 years and, *by going contrary to the teachings of the prior art as to what constituted good photographic practice,* produced a new mode of operating the old combination, which materially changed its operative effect and provided a new, entirely unexpected and highly beneficial result.

The fact that the combination of elements was old, does not negative invention in a new mode of operating them. (*Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403.)

**Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84; *Toledo Co. v. Standard Parts*, 307 U. S. 350.

In the *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, case, as well as the other cases relied upon by the Court below, this Court had before it so-called inventions involving combinations of old elements wherein each element continued to perform nothing more than its normal and expected function in the expected manner. For that reason, in the *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, case, this Court adopted a very apt simple arithmetic problem to illustrate the logical conclusion that a combination of old elements, to be patentable, must produce a combined result amounting to something more than normally would be expected by one having knowledge of the customary functions of the elements.

However, in the instant case, the del Riccio method steps add up to a "sum" which no skilled photographer, lacking del Riccio's inventiveness, would expect.

An examination of the prior art shows that del Riccio was the first to align *one edge* of the slit in the film masking plate with the optical axis of the lens and the finish line; and that del Riccio was the first to use the slit camera to photograph a number of objects, moving side by side across a fixed line.

Among the decisions of this Court are many which afford a directly analogous and helpful basis of approach in evaluating del Riccio's discovery. Typical of those cases is *Keystone Mfg. Co. v. Adams,* 151 U. S. 142.

In the *Keystone* case, the patent concerned improvements in a corn sheller. Prior art corn shellers had all possessed the fault that the throat through which the ears of corn descended from the hopper would become choked up by the ears wedging in the throat. This required that the

machines be stopped frequently so that the throat could be cleared. Those working in the art had always considered it necessary to provide a paddle wheel in the hopper and rotate it to *push* the ears of corn through the throat. The patentee overcame the choking problem by using precisely the same old combination of elements, but, instead of rotating the paddle wheel to push the ears through the throat, he rotated it in the reverse direction to retard the gravity movement of the ears. He did nothing more. His improved sheller promptly supplanted the old shellers, as the del Riccio method has supplanted other methods. In sustaining the corn sheller patent this Court said:

> "The change was a substantial and meritorious one and one which was well worthy of a patent by reason of the improvements which it produced *in the operative effect of the corn sheller.*"

The analogy is clear. *Viewed in retrospect,* it appeared to be a simple thing to reverse the rotation of the wheel* but the Court took the view that because others had gone on using the old and unsatisfactory corn shellers for years, it indicated that the solution was not as obvious as it appeared after the patentee taught the way. The same may be said of the del Riccio method. Those working in the art had had the slit camera before them for thirty-seven years, but nevertheless they had gone on using makeshift and unreliable methods without discovering what the Court below has said is too obvious to merit patentability.

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*"Viewed after the event, the means . . . adopted seem simple and such as should have been obvious to those who work in the field, but this is not enough to negative invention." (*Goodyear Tire & Rubber Co. v. Rayovac,* 321 U. S. 275.)

While horse racing is not one of our more critical industries, nevertheless it has long been sanctioned because it encourages the breeding of better horses, and the del Riccio method tends to make it a much cleaner sport since, by eliminating the possibility of error in determining the winner, it discourages attempts at corrupt practices.

Conclusion.

Petitioners respectfully submit therefore that this petition should be granted.

Respectfully submitted,

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DON MARLIN,
WILLIAM H. LEVIT,
Attorneys for Petitioner Lorenzo del Riccio.

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OCT 1 1951
CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

October Term, 1951

No. 290

PHOTOCHART, a Corporation, and LORENZO DEL RICCIO,
Petitioners,

v.

PHOTO PATROL, INC., a Corporation; PACIFIC TURF CLUB, INC., a Corporation; AMERICAN TELETIMER CORPORATION and ROBERT OSWALD,
Respondents.

BRIEF OF RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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BRIEF OF RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

The Petition Sets Forth No Adequate Reason for Granting the Writ.

"This is an ordinary patent case." Thus this court in the case of *Layne & Bowler Corporation* v. *Western Well Works, Inc., et al.*, 261 U. S. 387, 388, introduced its decision. The grounds upon which certiorari should be granted were stated at page 393:

> "* * * it is very important that we be consistent in not granting the writ of certiorari except in cases involving principles the settlement of which is of importance to the public as distinguished from that

> of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the circuit courts of appeal. The present case certainly comes under neither head."

The two conditions were restated in *Magnum Import Co., Inc.* v. *Coty*, 262 U. S. 159, 163:

> "The jurisdiction was not conferred upon this court merely to give the defeated party in the Circuit Court of Appeals another hearing."

In the present case neither of the two conditions for granting the writ of certiorari is present. There is no conflict with any decision of any other Court of Appeals and there is no question of public interest involved. As a matter of fact the sole point raised by the petition is complaint that the District Court and the Court of Appeals for the Ninth Circuit held claims 1, 2, 7 and 8 of Reissue Letters Patent No. 22,881 invalid.

It should be emphasized that the District Court found and decreed not only that the claims were invalid, but also that they had not been infringed by respondents. (R. 71, 72, 75, 87, 90, 91, 101) Thus, even as between the parties litigant, a holding that the claims in suit are valid, rather than invalid, would not alter the fact that the ultimate judgment must be entered for respondents. Hence, as far as public interest is concerned, this petition raises not a ripple. Further, the petition presents no special or important reasons why the writ should be granted.

This is an ordinary patent case involving the sole question of validity of four claims of a reissued patent. The following statement by this Court in *Keller* v. *Adams-Campbell Co.*, 264 U. S. 314, 317 is, therefore, controlling:

> "Such an ordinary patent case, with the usual issues of invention, breadth of claims, and non-infringement, this court will not bring here by certiorari unless it be necessary to reconcile the decisions of circuit courts of appeal on the same patent."

Reasons Relied Upon by Petitioner Insufficient to Justify the Writ of Certiorari.

The petitioners complain of injustice resulting from the judgments below and assert that a serious question of public importance is involved. The serious question of public importance is said to be that the United States Court of Appeals for the Ninth Circuit misconstrued the decision of this Court in *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Co.,* 340 U. S. 147, as announcing a new and more severe test of invention.

Actually the Court below relied upon several other decisions of this Court in addition to *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Co., supra,* which control the outcome of the holding of invalidity. Thus the Court of Appeals for the Ninth Circuit stated (R. 526):

> "The test to be applied to such patents is that the combination must perform some new or different function—one that has unusual or surprising consequences. It is our view that the patent in suit fails to meet this severe test and does not constitute invention. The most that can be said for the patent in suit is that it rearranges the elements of the slit camera in such a manner that in the performance of their respective functions a higher degree of accuracy is obtained. But perfection of workmanship, however useful or convenient, does not constitute invention. Cuno Corp. v. Automatic Devices Corp., 314 U. S. 84; Dow Chemical Co. v. Halliburton Oil Well Cementing Co., 324 U. S. 320; * * *."

The District Court decided this case in favor of respondents before the opinion in the *Supermarket* case was announced.

The litigation has run its gamut. The District Court in its judgment (R. 61-64) 89 Fed. Supp. 198, adjudged the subject claims to be invalid for lack of invention and

not infringed. The petitioners moved for a new trial and after a full hearing the motion was denied (R. 100). Petitioners appealed to the Court of Appeals for the Ninth Circuit and that Court affirmed the District Court (R. 520-530), 181 Fed. 2d 625. Petitioners' petition for rehearing was denied (R. 531). The petition to this Court is merely a complaint that the litigation has not been successful so far as petitioners are concerned.

CONCLUSION

Respondents submit that the petition for the writ of certiorari should be denied.

Respectfully submitted,

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IN THE

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October Term, 1951.
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Petitioners,

vs.

PHOTO PATROL, INC., a Corporation, PACIFIC TURF CLUB, INC., a Corporation, AMERICAN TELETIMER CORPORATION, and ROBERT A. OSWALD,
Respondents.

Petition for Rehearing of Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

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Respondents.

Petition for Rehearing of Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

To the Honorable, the Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

On August 30, 1951, your petitioners, Photochart, a corporation, and Lorenzo del Riccio, plaintiffs-appellants below, filed Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit, to review a judgment of that Court [R. 530] entered June 11, 1951, affirming a judgment in a patent case [R. 87] holding invalid claims 1, 2, 7 and 8 of the United States Reissue Letters Patent No. 22,881 [R. 393].

Said petition was denied by this Court on November 5, 1951. The time within which Petition for Rehearing may be filed herein was extended to December 10, 1951, by order of this Court.

Your petitioners now respectfully petition for a rehearing of said Petition for Writ of Certiorari.

Jurisdiction.

Jurisdiction of this Court is based upon Section 1254 of Title 28, U. S. C. A. Petition for rehearing is authorized by Rule 33 of this Court.

Statement.

The patent in suit teaches a method of so correlating the elements of a slit camera with a fixed line (such as the finish line of a race course) as to overcome the old and serious problem of "angular viewing" in photographing a number of objects (such as race contestants) moving side by side past such fixed line. The patented method was the first to eliminate all margin of error in photographing the finish of a track event, although all the elements of the slit camera had been before the art for 37 years.

In its opinion [R. 520], the court below not only recognized the novelty of the patented method over the prior art, but also recognized that it produced an improved result. However, the Court's decision appears to have been based upon its view that this Court's opinions in *Great Atlantic & Pacific Tea Co. v. Supermarket*

Equipment Corp., 340 U. S. 147; *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84; *Toledo Co. v. Standard Parts*, 307 U. S. 350, announced a new doctrine, to the effect that where a combination produces merely an improved result as distinguished from a new and different function, it is unpatentable. In arriving at this conclusion, the Court below appears to have misconstrued this Court's opinions, in the above identified cases, as being intended to overrule this Court's former decisions upholding patentability of inventions which produced only improved results as distinguished from new and different functions.

New Question Presented by This Petition.

The opinion and judgment below therefore raise this substantial question:

> "Did this Court, by its opinions in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147; *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84; *Toledo Co. v. Standard Parts*, 307 U. S. 350 overrule its prior decisions holding that an improved result as distinguished from a new and different function was sufficient to sustain a patent?"

While this question was availabe for presentation in the original Petition for Writ of Certiorari, it was not raised because petitioners felt that the questions presented were adequate to warrant issuance of the writ.

Additional Reasons for Allowance of Petition.

If the court below was wrong in construing the intent of this Court's opinions, and petitioners submit that it was in error, not only does the opinion below constitute an extremely dangerous precedent, but, unless corrected, it will result in a grave injustice to petitioners.

The patent statute (35 U. S. C. 31) has always provided that anyone who invents or discovers "any new and useful *improvements*" in any art, machine, manufacture, or combination of matters, is entitled to a patent.

This Court has always held that a meritorious invention or discovery which produces a useful, improved result as distinguished from an entirely new and different function, is patentable.

> *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U. S. 45;
>
> *Keystone Mfg. Co. v. Adams*, 151 U. S. 142.

For instance, in *Eibel Process Co. v. Minnesota & Ontario Paper Co., supra*, the patentee improved paper making machinery merely by elevating one of the elements to take greater advantage of gravity flow. Although each element of the machine continued to perform in its same old way, the invention increased the capacity of the machine by at least 25%, and this Court sustained the patent as a substantial advance in the art. It is not believed that this Court intended, by its later decisions above mentioned, to overrule its prior decisions, which were clearly in accordance with the language and intent of the patent statute.

Wherefore, Your Petitioners Pray that a rehearing be granted and that the Petition for Writ of Certiorari be issued.

Respectfully submitted,

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By COLLINS MASON,
Attorney for Photochart, a Corporation.

DON MARLIN and
WILLIAM H. LEVIT,
By DON MARLIN,
Attorneys for Petitioner Lorenzo del Riccio.

I hereby certify that this petition is presented in good faith and not for delay and that the same is restricted to a ground deemed to be substantial and which, although available, was not previously presented as a reason for grant of the Petition for Writ of Certiorari prayed for.

COLLINS MASON.